REMARKS

AMENDED CLAIMS

Applicants have amended claim 10 to repair a minor typographical error. In claim 10, Applicants have replaced the word 'method' with the word 'system.'

CLAIM REJECTIONS – 35 U.S.C. §102 OVER MOUSSEAU

Claims 1, 4-6, 9-11, and 14-15 stand rejected under 35 U.S.C § 102(e) as being anticipated by Mousseau, et al. (U.S. Patent No. 6,438,585). To anticipate claims 1, 4-6, 9-11, and 14-15 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Mousseau must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Mousseau must enable Applicants' claims. As will be shown below, Mousseau does not meet either requirement and therefore does not anticipate Applicants' claims.

Mousseau Does Not Disclose Each and Every Element Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Mousseau does not disclose each and every element of claim 1, and Mousseau therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 1 of the present application claims:

1. A method of email administration comprising the steps of:

   receiving through a transcoding gateway an email message, wherein

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the email message comprises at least one digital object having a digital object type;

the transcoding gateway is coupled to one or more display devices, and

the transcoding gateway comprises, for each display device, a display device record comprising display format attributes of each display device, wherein the display format attributes include a display format type for each display device;

finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type;

transcoding the digital object in dependence upon the display format attributes of the destination display device; and

displaying the transcoded digital object on the destination display device.

Mousseau Does Not Disclose Receiving Through A Transcoding Gateway An Email Message

The first element of claim 1 claims, among other things, "receiving through a transcoding gateway an email message...." Regarding the first element of claim 1, the Office Action at pages 2 and 3 states that Mousseau at Figure 6, reference numerals 200 and 210, discloses:

receiving through a transcoding gateway (Fig. 6 element 210) an email message (Fig 6 element 200)...

That is, the Office Action takes the position that Mousseau at Figure 6, reference numerals 200 and 210, discloses the first limitation of the first element of claim 1. Applicants respectfully note in response, however, that Mousseau at column 15, lines 46-65, describes reference numerals 200 and 210 stating:

In the system shown in FIG. 6, a datagram with an attached file 200 is sent to the host system 202. The host system 202 then sends the datagram with the attachment 200 intact to the desktop 204A of the recipient of the

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datagram 200 via the datagram component 202A. The datagram
component 202A recognizes the recipient address in the datagram 200 and
subsequently forwards the datagram 200 on to the desktop system 214A.
The redirector component 202B of the host system 202B also sends the
datagram 200A, stripped of the attachment 200B, through the host firewall
206 to the relay 210 and then on to the mobile device 214B via the
Internet 208 and the wireless network 212. In a preferred embodiment, the
attachment 200B is not initially redirected by the host system 202 when
the datagram 200A is redirected. Alternatively, it is possible that
automatic forwarding of attachments is possible; especially if the
attachment is in a format that can be handled by the mobile device. The
datagram 200A contains the original message and also contains
information about the attachment 200B, such as the file name, size, and
file type.

That is, Mousseau at column 15, lines 46-65, describes reference numerals 200 and 210
as a datagram and a relay that forwards a datagram from a host system to a mobile
device. Mousseau's datagram and a relay that forwards a datagram from a host system to
a mobile device is not receiving through a transcoding gateway an email message as
claimed in the present application because the relay of Mousseau is not the transcoding
gateway of the present application. In the paragraph beginning at page 10, line 7, of the
original application, Applicants describe the 'transcoding gateway' stating:

A "transcoding gateway" is a server capable of transcoding messages from
one format to another, as for example, from email objects to files stored in
file systems or from digital object in emails to transcoded digital object
suitable for display upon display devices, including for example, video
screen, audio players, digital art frames, television sets controlled by set
top boxes, text to speech converters in automobiles, and so on.
Transcoding gateways are "gateways" in the sense that they carry out their
server functions by use of [more] than one protocol, as for example, a
transcoding gateway that receives email messages using POP and
distributes digital objects in HTML documents using HTTP. Transcoding
gateways also are 'gateways' in the sense that they implement uplinks
between LANs and WANs; in many embodiments, a WAN so uplinked is
an Internet.

That is, a 'transcoding gateway' as claimed in the present application is a server capable
of transcoding messages from one format to another. Mousseau's relay identified by
reference numeral 210 merely forwards a datagram without performing any transcoding.

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Mousseau's relay has nothing whatsoever to do with a transcoding gateway as claimed in the present application. Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Disclose Finding A Display Device Record For A Destination Display Device, Wherein The Destination Display Device Comprises A Display Device Having A Display Format Type That Is The Same As The Digital Object Type

The second element of claim 1 claims "finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type...." Regarding the second of element of claim 1, the Office Action states that Mousseau at column 16, lines 4-42, lines 64-67, and column 17, lines 1-16, discloses:

> finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type (column 16 lines 2-42, lines 64-67) (column 17 lines 1-16);

That is, the Office Action takes the position that Mousseau at column 16, lines 4-42 and lines 64-67, and column 17, lines 1-16, discloses the second element of claim 1. Applicants respectfully note in response, however, that what Mousseau at column 16, lines 4-42, in fact discloses is:

> Alternatively, the mobile device 214B or user may automatically attempt to find an attachment displayer when the datagram 200A is received. Preferably through short range wireless communication 215A, 215B, the mobile device 214B will query 215A attachment displayers 216 in the local area of the mobile device 214B to determine whether they can process the attachment 200B. The attachment displayers 216 will then send back 215B to the mobile device 214B information pertaining to their location, electronic address, and the type of attachment files they can handle. The mobile device then processes this information regarding the attachment displayers 216, and sends the host system 202 an attachment displayer choice to use with the attachment 200B. The attachment

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component 202C of the host system receives the attachment displayer choice from the mobile device 214B, and will then send the attachment 200B to the chosen attachment displayer either through the wireless network 212, directly through the Internet 208, via a LAN connection, via a telephone or cellular connection, or via any other type of connection as specified by the information provided from the chosen attachment displayer 216.

In an alternative embodiment of this system, the attachment component 202C of the host system 202 would contain a database of attachment displayers 216 to which it sends attachments 200B by default depending on the file type. This database would include such information as displayer location, compatibility, and security. In this embodiment of the system, the mobile device does not choose attachment displayer 216 in real-time, although the user may configure the system in advance to use a particular attachment displayer 216 contained in the database. Alternatively, the host system 202 may prompt the user of the mobile device 214B to select from a list of potential attachment displayers 216, or the host may actively determine the location of the mobile device 214B, and then present a list of potential attachment displayers 216 for selection by the user based upon positioning information of the mobile device in relation to the potential attachment displayers 216.

That is, Mousseau at column 16, lines 4-42, discloses a mobile device finding an attachment displayer within its vicinity to process the attachment. Mousseau's mobile device that finds an attachment displayer within its vicinity to process the attachment is not finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type as claimed in the present application. Readers will recall from the first element of claim 1 above that the 'display device record' in the second element of claim 1 is included in a transcoding gateway. As explained above, the references cited in the Office Action do not disclose a transcoding gateway. Because the 'display device record' in the second element of claim 1 is included in a transcoding gateway and the references cited in the Office Action do not disclose a transcoding gateway, Mousseau at column 16, lines 4-42, cannot disclose "finding a display device record for a destination display device..." as claimed in the second element of claim 1. Furthermore, Mousseau at column 16, lines 4-42, never even once mentions a 'record,' 'display device record,' 'finding a display device record for a destination display device,'

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or 'finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type.' Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Mousseau at column 16, lines 64-67, and column 17, lines 1-16, Applicants respectfully note in response, however, that what Mousseau at column 16, lines 64-67, and column 17, lines 1-16, in fact discloses is:

> Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202 determines whether the attachment 200B is a compatible format for at least one of the attachment displayers 216 that were discovered in step 224. If a compatible attachment displayer is found, then this device is selected for processing the attachment 200B. If a compatible device is not found, however, then in step 228 the attachment 200B is converted into a suitable format by the host system 202 for one of the discovered attachment displayers 216. In step 230, the attachment displayer 216 selected by the host system 202 then sends the mobile device 214B its electronic routing address. This electronic address can be an IP address, a telephone number, or a machine address. The mobile device 214B then sends the routing address of the attachment displayer 216 back to the host system 202 in step 232. In step 234, the attachment component 202C of the host system 202 uses the routing address to redirect the converted attachment 200B to the selected attachment displayer 216. The host system 202 then notifies the mobile device 214B, in step 236 that the attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses a host that converts an attachment into a suitable format for an attachment displayer. Mousseau's host that converts an attachment into a suitable format for an attachment displayer is not finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type as claimed in the present application. Readers will recall from the first element of claim 1 above that the 'display device record' in the

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second element of claim 1 is included in a transcoding gateway. As explained above, the references cited in the Office Action do not disclose a transcoding gateway. Because the 'display device record' in the second element of claim 1 is included in a transcoding gateway and the references cited in the Office Action do not disclose a transcoding gateway, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, cannot disclose "finding a display device record for a destination display device..." as claimed in the second element of claim 1. Furthermore, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, never even once mentions a 'record,' 'display device record,' 'finding a display device record for a destination display device,' or 'finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type.' Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Disclose Transcoding The Digital Object In Dependence Upon The Display Format Attributes Of The Destination Display Device

The third of element 1 of claim 1 claims "transcoding the digital object in dependence upon the display format attributes of the destination display device...." Regarding the third element of claim 1, the Office Action states that Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses:

> transcoding the digital object in dependence upon the display format attributes of the destination display device (column 16 lines 64-67)(column 17 lines 1-16);

That is, the Office Action takes the position that Mousseau at column 16, lines 64-67, and column 17, lines 1-16, teaches the third element of claim 1. Applicants respectfully note in response, however, that what Mousseau at column 16, lines 61-67, and column 17, lines 1-16, in fact discloses is:

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Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202 determines whether the attachment 200B is a compatible format for at least one of the attachment displayers 216 that were discovered in step 224. If a compatible attachment displayer is found, then this device is selected for processing the attachment 200B. If a compatible device is not found, however, then in step 228 the attachment 200B is converted into a suitable format by the host system 202 for one of the discovered attachment displayers 216. In step 230, the attachment displayer 216 selected by the host system 202 then sends the mobile device 214B its electronic routing address. This electronic address can be an IP address, a telephone number, or a machine address. The mobile device 214B then sends the routing address of the attachment displayer 216 back to the host system 202 in step 232. In step 234, the attachment component 202C of the host system 202 uses the routing address to redirect the converted attachment 200B to the selected attachment displayer 216. The host system 202 then notifies the mobile device 214B, in step 236 that the attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses a converting an attachment into a suitable format for an attachment displayer. Mousseau's converting an attachment into a suitable format for an attachment displayer is not transcoding the digital object in dependence upon the display format attributes of the destination display device. Readers will recall from the first element of claim 1 above that the 'display format attributes' in the third element of claim 1 are included in a display device record that is included in a transcoding gateway. As explained above, the references cited in the Office Action do not disclose a transcoding gateway. Because the 'display format attributes' in the third element of claim 1 is included in a transcoding gateway and the references cited in the Office Action do not disclose a transcoding gateway, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, cannot disclose "transcoding the digital object in dependence upon the display format attributes of the destination display device" as claimed in the third element of claim 1. Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

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Mousseau Does Not Disclose Displaying The Transcoded
Digital Object On The Destination Display Device

The fourth of element 1 of claim 1 claims "displaying the transcoded digital object on the destination display device." Regarding the fourth element of claim 1, the Office Action at page 4 states that Mousseau at column 16, lines 64-67, column 17, lines 1-16; and, column 18, lines 31-38, discloses:

> displaying the transcoded digital object on the destination display device (column 16 lines 64-67)(column 17 lines 1-16)(column 18 lines 31-38).

That is, the Office Action takes the position that Mousseau at column 16, lines 64-67, column 17, lines 1-16; and, column 18, lines 31-38, discloses the fourth element of claim 1. Applicants respectfully note in response, however, that what Mousseau at column 16, lines 64-67, column 17, lines 1-16, and, column 18, lines 31-46, in fact discloses is:

> Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202 determines whether the attachment 200B is a compatible format for at least one of the attachment displayers 216 that were discovered in step 224. If a compatible attachment displayer is found, then this device is selected for processing the attachment 200B. If a compatible device is not found, however, then in step 228 the attachment 200B is converted into a suitable format by the host system 202 for one of the discovered attachment displayers 216. In step 230, the attachment displayer 216 selected by the host system 202 then sends the mobile device 214B its electronic routing address. This electronic address can be an IP address, a telephone number, or a machine address. The mobile device 214B then sends the routing address of the attachment displayer 216 back to the host system 202 in step 232. In step 234, the attachment component 202C of the host system 202 uses the routing address to redirect the converted attachment 200B to the selected attachment displayer 216. The host system 202 then notifies the mobile device 214B, in step 236 that the attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses converting an attachment into a suitable format for an attachment displayer. Mousseau's converting an attachment into a suitable format for an attachment displayer is not

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displaying the transcoded digital object on the destination display device as claimed in the present application. In fact, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, never even once mentions 'displaying the transcoded digital object on the destination display device,' 'displaying the transcoded digital object,' or even 'displaying' anything. Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Turning now to Mousseau at column 18, lines 31-46, Applicants respectfully note in response, however, that what Mousseau at column 18, lines 31-46, discloses is:

> In one embodiment of the attachment processing component 202C, attachments are "trimmed" in that only a portion of the attachment 200B is sent to the mobile device 214B. If the user after viewing the attachment desires to see the rest of the attachment, then the user may send a command to push the remaining portion of the attachment to the mobile device 214B. Alternatively, the user may request the attachment to be sent to an attachment displayer 216.

That is, Mousseau at column 18, lines 31-46, discloses a user requesting an attachment be sent to an attachment displayer. Mousseau's user request for an attachment to be sent to an attachment displayer is not displaying the transcoded digital object on the destination display device as claimed in the present application. In fact, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, never even once mentions 'displaying the transcoded digital object on the destination display device,' 'displaying the transcoded digital object,' or even 'displaying' anything. Because Mousseau does not disclose each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Enable Each and Every Element Of The Claims Of The Present Application

Not only must Mousseau disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims,

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but also Mousseau must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in Hoeksema stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Mousseau places Applicants' claims in the possession of a person of ordinary skill in the art, Mousseau is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Independent claim 1 of the present application claims:

1. A method of email administration comprising the steps of:

   receiving through a transcoding gateway an email message, wherein

   > the email message comprises at least one digital object having a digital object type;

   > the transcoding gateway is coupled to one or more display devices, and

   > the transcoding gateway comprises, for each display device, a display device record comprising display format attributes of each display device, wherein the display format attributes include a display format type for each display device;

   finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type;

   transcoding the digital object in dependence upon the display format attributes of the destination display device; and

   displaying the transcoded digital object on the destination display device.

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Mousseau Does Not Place In The Possession Of A Person Of Ordinary Skill In The Art Receiving Through A Transcoding Gateway An Email Message

The first element of claim 1 claims, among other things, "receiving through a transcoding gateway an email message...." Regarding the first element of claim 1, the Office Action at pages 2 and 3 states that Mousseau at Figure 6, reference numerals 200 and 210, discloses:

> receiving through a transcoding gateway (Fig. 6 element 210) an email
> message (Fig 6 element 200)...

That is, the Office Action takes the position that Mousseau at Figure 6, reference numerals 200 and 210, discloses the first limitation of the first element of claim 1. Applicants respectfully note in response, however, that Mousseau at column 15, lines 46-65, describes reference numerals 200 and 210 stating:

> In the system shown in FIG. 6, a datagram with an attached file 200 is sent
> to the host system 202. The host system 202 then sends the datagram with
> the attachment 200 intact to the desktop 204A of the recipient of the
> datagram 200 via the datagram component 202A. The datagram
> component 202A recognizes the recipient address in the datagram 200 and
> subsequently forwards the datagram 200 on to the desktop system 214A.
> The redirector component 202B of the host system 202B also sends the
> datagram 200A, stripped of the attachment 200B, through the host firewall
> 206 to the relay 210 and then on to the mobile device 214B via the
> Internet 208 and the wireless network 212. In a preferred embodiment, the
> attachment 200B is not initially redirected by the host system 202 when
> the datagram 200A is redirected. Alternatively, it is possible that
> automatic forwarding of attachments is possible; especially if the
> attachment is in a format that can be handled by the mobile device. The
> datagram 200A contains the original message and also contains
> information about the attachment 200B, such as the file name, size, and
> file type.

That is, Mousseau at column 15, lines 46-65, describes reference numerals 200 and 210 as a datagram and a relay that forwards a datagram from a host system to a mobile device. Mousseau's datagram and a relay that forwards a datagram from a host system to

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a mobile device is not receiving through a transcoding gateway an email message as claimed in the present application because the relay of Mousseau is not the transcoding gateway of the present application. In the paragraph beginning at page 10, line 7, of the original application, Applicants describe the 'transcoding gateway' stating:

> A "transcoding gateway" is a server capable of transcoding messages from one format to another, as for example, from email objects to files stored in file systems or from digital object in emails to transcoded digital object suitable for display upon display devices, including for example, video screen, audio players, digital art frames, television sets controlled by set top boxes, text to speech converters in automobiles, and so on. Transcoding gateways are "gateways" in the sense that they carry out their server functions by use of [more] than one protocol, as for example, a transcoding gateway that receives email messages using POP and distributes digital objects in HTML documents using HTTP. Transcoding gateways also are 'gateways' in the sense that they implement uplinks between LANs and WANs; in many embodiments, a WAN so uplinked is an Internet.

That is, a 'transcoding gateway' as claimed in the present application is a server capable of transcoding messages from one format to another. Mousseau's relay identified by reference numeral 210 merely forwards a datagram without performing any transcoding. Mousseau's relay has nothing whatsoever to do with a transcoding gateway as claimed in the present application. Because Mousseau does not place in the possession of a person of ordinary skill in the art each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Place In The Possession Of A Person Of Ordinary Skill In The Art Finding A Display Device Record For A Destination Display Device, Wherein The Destination Display Device Comprises A Display Device Having A Display Format Type That Is The Same As The Digital Object Type

The second element of claim 1 claims "finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type...." Regarding the second of element of claim 1, the Office Action states that Mousseau at column 16, lines 4-42,

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lines 64-67, and column 17, lines 1-16, discloses:

> finding a display device record for a destination display device, wherein
> the destination display device comprises a display device having a display
> format type that is the same as the digital object type (column 16 lines 2-
> 42, lines 64-67) (column 17 lines 1-16);

That is, the Office Action takes the position that Mousseau at column 16, lines 4-42 and

lines 64-67, and column 17, lines 1-16, discloses the second element of claim 1.

Applicants respectfully note in response, however, that what Mousseau at column 16,

lines 4-42, in fact discloses is:

> Alternatively, the mobile device 214B or user may automatically attempt
> to find an attachment displayer when the datagram 200A is received.
> Preferably through short range wireless communication 215A, 215B, the
> mobile device 214B will query 215A attachment displayers 216 in the
> local area of the mobile device 214B to determine whether they can
> process the attachment 200B. The attachment displayers 216 will then
> send back 215B to the mobile device 214B information pertaining to their
> location, electronic address, and the type of attachment files they can
> handle. The mobile device then processes this information regarding the
> attachment displayers 216, and sends the host system 202 an attachment
> displayer choice to use with the attachment 200B. The attachment
> component 202C of the host system receives the attachment displayer
> choice from the mobile device 214B, and will then send the attachment
> 200B to the chosen attachment displayer either through the wireless
> network 212, directly through the Internet 208, via a LAN connection, via
> a telephone or cellular connection, or via any other type of connection as
> specified by the information provided from the chosen attachment
> displayer 216.

> In an alternative embodiment of this system, the attachment component
> 202C of the host system 202 would contain a database of attachment
> displayers 216 to which it sends attachments 200B by default depending
> on the file type. This database would include such information as displayer
> location, compatibility, and security. In this embodiment of the system, the
> mobile device does not choose attachment displayer 216 in real-time,
> although the user may configure the system in advance to use a particular
> attachment displayer 216 contained in the database. Alternatively, the host
> system 202 may prompt the user of the mobile device 214B to select from
> a list of potential attachment displayers 216, or the host may actively
> determine the location of the mobile device 214B, and then present a list

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of potential attachment displayers 216 for selection by the user based upon positioning information of the mobile device in relation to the potential attachment displayers 216.

That is, Mousseau at column 16, lines 4-42, discloses a mobile device finding an attachment displayer within its vicinity to process the attachment. Mousseau's mobile device that finds an attachment displayer within its vicinity to process the attachment is not finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type as claimed in the present application. Readers will recall from the first element of claim 1 above that the 'display device record' in the second element of claim 1 is included in a transcoding gateway. As explained above, the references cited in the Office Action do not disclose a transcoding gateway. Because the 'display device record' in the second element of claim 1 is included in a transcoding gateway and the references cited in the Office Action do not disclose a transcoding gateway, Mousseau at column 16, lines 4-42, cannot disclose "finding a display device record for a destination display device..." as claimed in the second element of claim 1. Furthermore, Mousseau at column 16, lines 4-42, never even once mentions a 'record,' 'display device record,' 'finding a display device record for a destination display device,' or 'finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type.' Because Mousseau does not place in the possession of a person of ordinary skill in the art each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims. and the rejections should be withdrawn.

Turning now to Mousseau at column 16, lines 64-67, and column 17, lines 1-16, Applicants respectfully note in response, however, that what Mousseau at column 16, lines 64-67, and column 17, lines 1-16, in fact discloses is:

Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202

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determines whether the attachment 200B is a compatible format for at
least one of the attachment displayers 216 that were discovered in step
224. If a compatible attachment displayer is found, then this device is
selected for processing the attachment 200B. If a compatible device is not
found, however, then in step 228 the attachment 200B is converted into a
suitable format by the host system 202 for one of the discovered
attachment displayers 216. In step 230, the attachment displayer 216
selected by the host system 202 then sends the mobile device 214B its
electronic routing address. This electronic address can be an IP address, a
telephone number, or a machine address. The mobile device 214B then
sends the routing address of the attachment displayer 216 back to the host
system 202 in step 232. In step 234, the attachment component 202C of
the host system 202 uses the routing address to redirect the converted
attachment 200B to the selected attachment displayer 216. The host
system 202 then notifies the mobile device 214B, in step 236 that the
attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses a host

that converts an attachment into a suitable format for an attachment displayer.

Mousseau's host that converts an attachment into a suitable format for an attachment

displayer is not finding a display device record for a destination display device, wherein

the destination display device comprises a display device having a display format type

that is the same as the digital object type as claimed in the present application. Readers

will recall from the first element of claim 1 above that the 'display device record' in the

second element of claim 1 is included in a transcoding gateway. As explained above, the

references cited in the Office Action do not disclose a transcoding gateway. Because the

'display device record' in the second element of claim 1 is included in a transcoding

gateway and the references cited in the Office Action do not disclose a transcoding

gateway, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, cannot disclose

"finding a display device record for a destination display device..." as claimed in the

second element of claim 1. Furthermore, Mousseau at column 16, lines 64-67, and

column 17, lines 1-16, never even once mentions a 'record,' 'display device record,'

'finding a display device record for a destination display device,' or 'finding a display

device record for a destination display device, wherein the destination display device

comprises a display device having a display format type that is the same as the digital

object type.' Because Mousseau does not place in the possession of a person of ordinary

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skill in the art each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Place In The Possession Of A Person Of Ordinary Skill In The Art Transcoding The Digital Object In Dependence Upon The Display Format Attributes Of The Destination Display Device

The third of element 1 of claim 1 claims "transcoding the digital object in dependence upon the display format attributes of the destination display device...." Regarding the third element of claim 1, the Office Action states that Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses:

> transcoding the digital object in dependence upon the display format attributes of the destination display device (column 16 lines 64-67)(column 17 lines 1-16);

That is, the Office Action takes the position that Mousseau at column 16, lines 64-67, and column 17, lines 1-16, teaches the third element of claim 1. Applicants respectfully note in response, however, that what Mousseau at column 16, lines 61-67, and column 17, lines 1-16, in fact discloses is:

> Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202 determines whether the attachment 200B is a compatible format for at least one of the attachment displayers 216 that were discovered in step 224. If a compatible attachment displayer is found, then this device is selected for processing the attachment 200B. If a compatible device is not found, however, then in step 228 the attachment 200B is converted into a suitable format by the host system 202 for one of the discovered attachment displayers 216. In step 230, the attachment displayer 216 selected by the host system 202 then sends the mobile device 214B its electronic routing address. This electronic address can be an IP address, a telephone number, or a machine address. The mobile device 214B then sends the routing address of the attachment displayer 216 back to the host system 202 in step 232. In step 234, the attachment component 202C of the host system 202 uses the routing address to redirect the converted attachment 200B to the selected attachment displayer 216. The host

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system 202 then notifies the mobile device 214B, in step 236 that the attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses converting an attachment into a suitable format for an attachment displayer. Mousseau's converting an attachment into a suitable format for an attachment displayer is not transcoding the digital object in dependence upon the display format attributes of the destination display device. Readers will recall from the first element of claim 1 above that the 'display format attributes' in the third element of claim 1 are included in a display device record that is included in a transcoding gateway. As explained above, the references cited in the Office Action do not disclose a transcoding gateway. Because the 'display format attributes' in the third element of claim 1 is included in a transcoding gateway and the references cited in the Office Action do not disclose a transcoding gateway, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, cannot disclose "transcoding the digital object in dependence upon the display format attributes of the destination display device" as claimed in the third element of claim 1. Because Mousseau does not place in the possession of a person of ordinary skill in the art each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

Mousseau Does Not Place In The Possession Of A Person Of Ordinary Skill In The Art Displaying The Transcoded Digital Object On The Destination Display Device

The fourth of element 1 of claim 1 claims "displaying the transcoded digital object on the destination display device." Regarding the fourth element of claim 1, the Office Action at page 4 states that Mousseau at column 16, lines 64-67, column 17, lines 1-16; and, column 18, lines 31-38, discloses:

> displaying the transcoded digital object on the destination display device
> (column 16 lines 64-67)(column 17 lines 1-16)(column 18 lines 31-38).

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That is, the Office Action takes the position that Mousseau at column 16, lines 64-67, column 17, lines 1-16; and, column 18, lines 31-38, discloses the fourth element of claim 1. Applicants respectfully note in response, however, that what Mousseau at column 16, lines 64-67, column 17, lines 1-16, and, column 18, lines 31-46, in fact discloses is:

> Having obtained this information about the available attachment displayers 216, the mobile device 214B in this step 224 then transmits the availability information to the host system 202. In step 226, the host 202 determines whether the attachment 200B is a compatible format for at least one of the attachment displayers 216 that were discovered in step 224. If a compatible attachment displayer is found, then this device is selected for processing the attachment 200B. If a compatible device is not found, however, then in step 228 the attachment 200B is converted into a suitable format by the host system 202 for one of the discovered attachment displayers 216. In step 230, the attachment displayer 216 selected by the host system 202 then sends the mobile device 214B its electronic routing address. This electronic address can be an IP address, a telephone number, or a machine address. The mobile device 214B then sends the routing address of the attachment displayer 216 back to the host system 202 in step 232. In step 234, the attachment component 202C of the host system 202 uses the routing address to redirect the converted attachment 200B to the selected attachment displayer 216. The host system 202 then notifies the mobile device 214B, in step 236 that the attachment 200B has been redirected to the attachment displayer 216.

That is, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, discloses a converting an attachment into a suitable format for an attachment displayer. Mousseau's converting an attachment into a suitable format for an attachment displayer is not displaying the transcoded digital object on the destination display device as claimed in the present application. In fact, Mousseau at column 16, lines 64-67, and column 17, lines 1-16, never even once mentions 'displaying the transcoded digital object on the destination display device,' 'displaying the transcoded digital object,' or even 'displaying' anything. Because Mousseau does not place in the possession of a person of ordinary skill in the art each and every element and limitation of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the rejections should be withdrawn.

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Turning now to Mousseau at column 18, lines 31-46, Applicants respectfully note in
response, however, that what Mousseau at column 18, lines 31-46, discloses is:

> In one embodiment of the attachment processing component 202C,
> attachments are "trimmed" in that only a portion of the attachment 200B is
> sent to the mobile device 214B. If the user after viewing the attachment
> desires to see the rest of the attachment, then the user may send a
> command to push the remaining portion of the attachment to the mobile
> device 214B. Alternatively, the user may request the attachment to be sent
> to an attachment displayer 216.

That is, Mousseau at column 18, lines 31-46, discloses a user requesting an attachment be
sent to an attachment displayer. Mousseau's user request for an attachment to be sent to
an attachment displayer is not displaying the transcoded digital object on the destination
display device as claimed in the present application. In fact, Mousseau at column 16,
lines 64-67, and column 17, lines 1-16, never even once mentions 'displaying the
transcoded digital object on the destination display device,' 'displaying the transcoded
digital object,' or even 'displaying' anything. Because Mousseau does not place in the
possession of a person of ordinary skill in the art each and every element and limitation
of Applicants' claims, Mousseau does not anticipate Applicants' claims, and the
rejections should be withdrawn.

Relations Among Claims

Independent claim 1 is patentable for the reasons discussed above. Independent claim 6
claims system aspects of the method claimed in independent claim 1. Independent claim
11 claims computer program product aspects of the method claimed in independent claim
1. Independent claims 6 and 11 therefore are patentable for the same reasons that
independent claim 1 is patentable as described above. Dependent claims 4-5, 9-10, and
14-15 depend from independent claims 1, 6, and 11, respectively. The dependent claims
include each and every element and limitation of the independent claims from which they
depend. The dependent claims stand because their respective independent claims stand.
Claims 1, 4-6, 9-11, and 14-15 are therefore patentable and should be allowed.

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Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 4-6, 9-11, and 14-15.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 2-3, 7-8, and 12-13 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Mousseau, *et al.* (U.S. Patent No. 6,438,585) in view of Malik, *et al.*, (U.S. Patent No. 6,907,452). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 2-3, 7-8, and 12-13. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 2-3, 7-8, and 12-13 because the rejections of claims 2-3, 7-8, and 12-13 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Mousseau discloses each and every element and limitation of independent claims 1, 6, and 11. As Applicants have demonstrated above, however, Mousseau does not disclose each and every element of independent claims 1, 6, and 11. Claims 2-3, 7-8, and 12-13 depend from independent claims 1, 6, and 11. Each dependent claim includes all of the limitations of the claims from which they depend. Because the proposed combination relies on the argument that Mousseau discloses each and every element of claims 1, 6, and 11 and because Mousseau in fact does not disclose each and every element of claims 1, 6, and 11, the proposed combination cannot teach or suggest all the claim limitations of claims 2-3, 7-8, and 12-13. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

CONCLUSION

Claims 1, 4-6, 9-11, and 14-15 stand rejected under 35 U.S.C § 102(c) as being anticipated by Mousseau. For the reasons described above, Mousseau does not disclose or enable each and every element and limitation of Applicants' claims. The rejections of claims 1, 4-6, 9-11, and 14-15 should therefore be withdrawn.

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Claims 2-3, 7-8, and 12-13 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Mousseau in view of Malik. Because the proposed combination of Mousseau and Malik relies on the argument that Mousseau discloses each and every element of claims 1, 6, and 11 and because Mousseau in fact does not disclose each and every element of claims 1, 6, and 11, the proposed combination cannot teach or suggest all the claim limitations of claims 2-3, 7-8, and 12-13. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-15

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: <u>April 26, 2006</u>   By:

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